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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/769,933	02/02/2004	Craig S. Serio	29641/39824	9566

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EXAMINER

NGUYEN, TUAN N

ART UNIT PAPER NUMBER

3751

DATE MAILED: 11/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/769,933

Applicant(s)

SERIO ET AL.

Examiner

Tuan N. Nguyen

Art Unit

3751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-16 and 18-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-16 and 18-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-3, 5-16, and 18-28 have been considered but are moot in view of the new ground(s) of rejection presented below.

Specification

The abstract of the disclosure is objected to because it should avoid using phrases, which can be implied, such as, "The disclosure relates to" on line 1 of the abstract.

Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-3, 5-16, and 18-28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. While the specification recites a bottom surface 18, it did not recite the language "a cross-sectional area at least equal to the cross-sectional area of any other section of the container" in lines 7-8 of claim 1, in lines 8-9 of claim 14, and in lines 4-5 of claim 25. Therefore, the additional new language in claims 1, 14 and 25 are considered as new matter.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-3, 5-16, and 18-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gentile et al. (hereinafter Gentile) in view of Stewart.

In regard to claims 1, 9, 10, 14 and 23, Gentile discloses a paint applicator comprising a container (1) having an opening; and a housing assembly (see Fig. 2a) removably attached to the container, the housing assembly comprising a paint application element (14), which can be considered as "a paint pad" or "a paint roller cover", and a push-pull valve (see cols. 3-4), the paint application element being adjacent to the valve (see Fig. 2a), and the push-pull valve being in fluid communication with the container, wherein the container is shaped to include a gripping surface thereon (left and right sides of container 1, see Fig. 2a) to ergonomically receive the hand of a user and a bottom surface. Although the bottom surface of Gentile does not have a cross-sectional area at least equal to the cross-sectional area of any other section of the container as claimed, attention is directed to the Stewart reference, which discloses an analogous applicator comprises a container (13) having a bottom surface with a cross-sectional area at least equal to the cross-sectional area of any other section of the container (see Fig. 4). It is the examiner's position that to modify the Gentile container shape to have a bottom with a cross-sectional area at least equal to the cross-sectional

area of any other section of the container would involve mere design choice, which is a well known feature as, for example, taught by Stewart that would be well within the realm of obviousness to one of ordinary skill in the art.

In regard to claims 2 and 15, Gentile further discloses the housing assembly comprises a cap (about 2) adapted to substantially seal the opening of the container, and a cover (56) adapted to engage the cap.

In regard to claims 3 and 16, Gentile further discloses the paint applicator further comprises a "living hinge" (about 62, 64) connecting the cover to the cap. 4.

In regard to claims 5 and 18, Gentile further discloses the cap includes a recess (the recess under member 8, see Figs. 2a and 5) and the cover includes a projection (64, see Figs. 2a and 2b) adapted to interact with the recess to provide a snap-fit engagement between the cap and the cover.

In regard to claims 6 and 19, Gentile further discloses the cover includes a recess (between 62 and 64, see Figs. 2a and 2b) and the cap includes a projection (about member 8, see Figs. 2a and 5) adapted to interact with the recess to provide a snap-fit engagement between the cap and the cover.

In regard to claims 7 and 20, Gentile further discloses the cap is adapted to engage the paint application element (about 20, see Fig. 2b).

In regard to claims 8 and 21, Gentile further discloses the cover is adapted to engage the paint application element (via cap 2 when the cover 56 is place thereon).

In regard to claims 11 and 12, Gentile further discloses the push- pull valve comprises a face (about 12) having a contour that is complementary to an outer

diameter of the paint roller cover and the face is in contact with an outer diameter of the paint roller cover (see Fig. 2b).

In regard to claims 13 and 24, Gentile further discloses an aperture (about 18, see Fig. 2a) of the push-pull valve would be positioned above a centerline of the paint application element in use in an upside down position.


In regard to claims 25-28, the method as claimed would be inherent during normal use of the Gentile in view of Stewart device.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan N. Nguyen whose telephone number is 571-272-4892. The examiner can normally be reached on Monday-Friday (10:00-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Huson can be reached on (571) 272-4887. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


TUAN NGUYEN
PRIMARY EXAMINER
11/13/06